

U.S. Application No.: 10/614,095
Response to Office action of May 14, 2007
Attorney Docket No.: FSF-031401

REMARKS

Claims 1 and 2 have been amended. Claims 1-10 and 12 and withdrawn claims 13-20 are pending in the application.

I. Response to Claim Rejection under 35 U.S.C. § 112

Claims 1-10 and 12 were rejected under 35 U.S.C. § 112 second paragraph as being indefinite. The Examiner's concerns have been addressed by the present amendment which adopts the suggested language of "silver halide grains."

The Examiner has further stated that Claims 1 and 2 are indefinite due to the absence of providing specific amounts of iridium and the other metals. Applicant respectfully disagrees. The characteristic feature of the present invention is that Ir metal is primarily contained in the core rather than the shell, and specified metals other than Ir are primarily contained in the shell rather than the core. Therefore, the amounts of the metals should be recited as relative values.

II. Response to Claim Rejections Under 35 U.S.C. § 103 and § 102

A. Okada in view of Yanagisawa and EP ('310)

Claim 1-9 and 12 were rejected over U.S. Patent No. 6,120,983 to Okada et al. in view of U.S. 2002/0028414 to Yanagisawa et al. and EP 1096310. This rejection is respectfully traversed. Okada relates to a photothermographic material in which the silver halide has a core/shell structure including metal complexes. Okada states that the distribution of metal within the grains is not critical: "The distribution of the metal complex

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in silver halide grains is not critical. That is, the metal complex may be contained in silver halide grains to form a uniform phase or at a high concentration in either the core or the shell" (col. 36, lines 31-35).

In contrast, in the present invention, the distribution of the metal is critical and produces unexpected results as shown in the previous-filed declaration under 37 C.F.R. 1.132. Okada further fails to teach or suggest the claimed percentages which have been shown to be critical. Since Okada explicitly states that concentrations are not critical, one of ordinary skill in the art would not have been motivated to provide the particular ranges cited in the present claims.

Regarding the secondary references, they do not overcome the deficiencies of Okada since they do not teach or suggest the claimed concentration ranges of the present invention.

B. Rejection of Claims 1-10 and 12 over Oka

Claims 1-10 and 12 were rejected under 35 U.S.C. 102(e) over U.S. Patent Publication 2004/00055522 to Oka. This rejection is respectfully traversed. Oka does not teach or suggest the claimed percentages of metals in the core and shell portion of the grain. Therefore, it is respectfully submitted that this rejection should be under 35 U.S.C. 103, not 35 U.S.C. 102. Further, the reference is not available as prior art under the provisions of 35 U.S.C. 103(c) since the reference and the present application are commonly owned.

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STATEMENT OF COMMON OWNERSHIP

The current application, U.S. 10/614,095 and U.S. Patent Publication 2004/0005522 A1 to Oka et al. were, at the time the invention of application 10/614,095 was made, owned by Fuji Photo Film Co. Ltd. (now FujiFilm Corp.).

In view of the common ownership, it is respectfully requested that this rejection be withdrawn.

III. Response to Double Patenting Rejection

A terminal disclaimer accompanies this response.

In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



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September 14, 2007